

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MMB Docket No. 1776-0014

Xerox Docket No.: D/A-2451

Application of: **John A. Moore**

Group Art Unit: **2162**

Serial No.: **10/758,061**

Examiner: **Giovanna B. Colan**

Filed: **January 15, 2004**

Confirmation No.: **5102**

For: **Method And System For Managing Image Files In A Hierarchical  
Storage Management System**

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/David M. Lockman/

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September 8, 2008

Date of Signature

**REPLY BRIEF**

Hon. Commissioner of Patents and Trademarks

Alexandria, VA 20231

Sir:

In response to the Examiner's Answer, the Applicant replies with reasons as to why the Examiner has failed to refute the arguments put forth by the Applicant.

## ARGUMENT

In the Answer Brief, the Examiner has largely reiterated the positions put forth in the Final Office Action without substantively addressing the failure of the references to support the Examiner's position. A few examples are provided for the Board's consideration.

On page 15, the Examiner states that "RAM 2809 corresponds to the secondary storage of the host system." This statement is misleading in that reference number 2809 does not refer to RAM, which is identified with reference number 2802, but rather a storage medium drive. *See* FIG. 28 of Toda. Thus, drive 2809 is secondary storage to RAM 2802 as secondary storage is described in Applicant's specification. Yet, the Examiner argues that RAM 2802 is secondary storage, otherwise storage of the color document and the binary version in RAM 2802 cannot disclose the limitation at issue because claim 1 requires the image file and the downgraded file to be stored in secondary storage. The only way that the Examiner can equate RAM 2802 to secondary storage drive 2809 is to refer to drive 2809 as RAM. Such a reference is erroneous in light of FIG. 28 and demonstrates the inability of the Toda reference to support the ground of rejection.

On page 15, the Examiner states that ROM 2803 provides additional storage for image files. This assertion is contrary to the commonly understood meaning of ROM and the disclosure in Toda. "ROM" stands for Read Only Memory and refers to a non-volatile memory device in which data are stored. The processor of the system in which a ROM is installed is not able to write data into the ROM. Toda discloses this typical use of ROM by stating that control programs, boot programs, and setup data are stored in the ROM 2803. *Toda*, paragraph 135. Thus, ROM, contrary to the Examiner's assertion, cannot qualify as tertiary storage in which an image file may be stored.

In section C of the Response to Argument in the Examiner's Answer Brief, the Examiner asserts that the teaching of Toda regarding the reduction of black pixels is a disclosure of pixel reduction size. Yet, the discussion following the cited section of Toda, paragraph 63, seems to indicate a reduction in the range of pixel densities used to represent the

black pixels to a representative value is what Toda intends by a reduction in black pixels. Therefore, Toda does not provide the teaching for which the Examiner cited the reference and the reference does not adequately support the contested ground of rejection.

Likewise in section D of the Response to Argument, the Examiner fails to prove that the color data conversions cited in Toda result in less data for representation of a color. Thus, the Examiner fails to meet the requisite burden of proof that the cited reference does indeed teach the claim limitation.

On page 19, the Examiner argues that paragraphs 64 and 94 of Toda teach comparison of file metadata to a file access frequency threshold. Paragraph 64, however, refers to a maximum frequency of occurrence in a histogram, while paragraph 94 refers to coefficients of high frequency portions in an orthogonal transformation result. Clearly, neither of these references regard a file access frequency threshold. Existence of the word “frequency” in two paragraphs of Toda does not mean that the reference teaches a claim limitation that also includes the word “frequency.” Similar reasoning applies to the Examiner’s arguments in sections G and H of the Answer Brief.

The Examiner’s contentions that the black pixels of an image in Toda and the text areas formed by the text areas formed by the pixels correspond to file metadata and a file data volume, respectively, are simply unsupported by the reference. The black pixels are data *in* a file, and not data about the file. Likewise, a text area is not a storage repository for files. The Examiner fails to provide any citation to Toda that leads one to conclude otherwise. In a similar manner, sections J and K fail to explain how the black pixels (allegedly “metadata”) in Toda are compared to a downgrade threshold to identify an image file or how the black pixels are generated by a file controller.

## CONCLUSION

The Examiner has failed to rebut the arguments presented in Appellant's brief. Consequently, no *prima facie* case has been presented that renders the pending claims obvious in view of the cited references under 35 U.S.C. § 103(a). The Board of Appeals, therefore, is respectfully requested to reverse the rejection of the pending claims.

Respectfully submitted,

/David M. Lockman/  
David M. Lockman  
Attorney for Appellant  
Registration No. 34,214

September 8, 2008  
Maginot, Moore & Beck  
Bank One Center/Tower  
111 Monument Circle, Suite 3000  
Indianapolis, Indiana 46204-5130  
Telephone (317) 638-2922  
Facsimile (317) 638 2139